



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,817	11/08/2000	Jose Remacle	VANM160.001A	2892

20995 7590 05/27/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No. 09/582,817	Applicant(s) REMACLE, JOSE	
	Examiner Bradley L. Sisson	Art Unit 1634	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Bradley L. Sisson. (3) Marina Gordey, Reg. No. 52,950.
 (2) Dan Hart, Reg. No. 40,637. (4) _____.

Date of Interview: 24 May 2004.

Type: a) ☒ Telephonic b) ☐ Video Conference
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☒ Yes e) ☐ No.

If Yes, brief description: Preliminary amendment received with request for RCE on 17 May 2004.

Claim(s) discussed: 30,31,34,40,41,43-45 and 47.

Identification of prior art discussed: US Patent 6,030,581 (Virtanen).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The aspect of providing the full name for both CD and DVD was discussed. Acknowledgement was made for the specification providing the full name for CD (compact disc) but no full name was found for "DVD." Mr. Sisson indicated that he had interpreted the abbreviation as being that for "digital video disc" and indicated that such interpretation was reasonably supported by the disclosure, and would not be objected to should applicant introduce such a full name into the claims.

Mr. Hart directed attention to page 7, lines 21-27; page 11, lines 20-31; and page 12, lines 19-30 as providing written description for the claims encompassing a wide variety of discs, including discs that are multisided and of varying thicknesses. Mr. Sisson questioned as to whether elliptic, hexagonal, octagonal, etc., discs were known in the art at the time of filing, and whether the specification satisfies the written description requirement for such variants of discs that do not exist even as of this date.

Mr. Sisson directed attention to Claim 47 and expressed concern over how the claim is to be interpreted, especially as it relates to interpretation of the clause "used in the treatment." Mr. Sisson indicated that one interpretation is for there to be a "treatment . . . of the signal." Mr. Hart indicated that it is possible that the "treatment" is not that of the signal but of the CD or DVD as recited in Claim 30. Mr. Sisson indicated that given that there exists at least two different interpretations of the claim, that an issue under 35 USC 112, second paragraph, may well exist. Mr. Hart indicated that he would consider amending the claims so to clarify just what is being treated.

Mr. Sisson also directed attention to claim 50, which is indicated as being "Cancelled" in the amendment yet the text is provided. Mr. Sisson also indicated that the Office actions of 14 April 2004 and 23 September 2003 indicate that claim 50 has been withdrawn. Mr. Hart indicated that he would review the record, as it is possible that they did not intend to cancel claim 50, but to indicate that it was withdrawn. ** While not indicated in the interview, applicant is advised that upon entry of the amendment of May 2004, claim 50 will be cancelled and cannot be restored.

Mr. Sisson made inquiry as to how the term "pits," found at page 25, of the disclosure is to be interpreted. Mr. Hart indicated that the "pits" are not to be construed as reaction chambers or wells, but rather, are depressions that accompany lands as found on the surface of a CD or DVD. Mr. Hart directed attention to page 10, lines 11-14, as providing basis for this interpretation.

Mr. Hart presented argument that the CD and DVD of the claimed method do not comprise internal flow channels and reaction chambers; that the capture molecules are bound only to the surface of a disc, and that the discs are conventional CDs and DVDs and as such, the teachings of Virtanen do not anticipate or render obvious the claimed method. Mr. Sisson indicated that given applicant's assertions as to how broadly the CDs and DVDs are to be interpreted, such breadth of scope would also be present in interpreting the discs used for prior art purposes. Mr. Sisson noted that the claimed method does not recite any limitation that would preclude a disc from comprising flow channels, reaction chambers, etc. Mr. Sisson also noted that Virtanen, Fig. 1, shows "software" being present on one portion of one surface of a disc, while the sample is processed on yet another region of the disc. Mr. Hart indicated that he will consider filing a supplemental response whereby claim 30 will be further amended so to clarify the disc and where the capture molecule is bound. .